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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,378	02/25/2002	Olivier Parrault	BONN-072	7969

7590
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07/22/2003

EXAMINER

POLK, SHARON A

ART UNIT

PAPER NUMBER

2836

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/069,378	PARRAULT, OLIVIER	
	Examiner	Art Unit	
	Sharon Polk	2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/FR01/02011, filed on June 26, 2001. **Information Disclosure Statement**
2. The information disclosure statement (IDS) submitted on February 25, 2002 has been considered by the examiner.

Drawings

3. The drawings are objected to because the black boxes in figures 1 and 2 should be labeled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reader must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 15 is objected to because of the following informalities: According to MPEP § 608.01 (m) Form of Claims, where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. See also 37 CFR 1.75(i).

Claim 28 is also objected to because a device that "can be" is not a positively recited. Correction is required.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: retromodulation.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 28 it is unclear how what is understood to be embedded within a device, can be removed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berthold et al., US 4,506,148 in view of PCT/US95/08863.

With regard to **claim 15**, Berthold et al. teach a contactless portable object (fig. 1) comprising a main chip (4) and a main antenna (11) enabling communication between said chip and a reader (1) associated with said contactless portable object (2)

Berthold et al. lack the teaching of 1said portable contactless object further comprising at least one contactless peripheral device, having a function different than that of the main chip, not connected by ohmic contact to the latter and requiring only a small amount of energy to operate. However, PCT/US95/08863 teach the claimed features (e.g., figs. 1, and 3). One skilled in the art would have been motivated to modify Berthold et al. with the teachings of PCT/US95/08863 for the purpose of reducing interference between the first antenna and the second antenna (2:28-29).

With regard to **claims 21, and 22**, Berthold as modified by PCT/ US95/08863 teach the claimed contactless portable object, but lack the explicit teaching of tuning capacitors. However, official notice is taken that tuning capacitors are well known in the art for the purpose of adjusting the natural frequency to a desired one. As such one skilled in the art would have been motivated to incorporate tuning capacitors as part of the portable object for the purpose of providing optimum performance.

Claims 16-20, 23-25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berthold et al., in view of PCT/US95/08863, and further in view of Teicher et al., US 6,257,486.

With regard to claims **16, 23-25, 23-25, and 27** Berthold as modified by PCT/US95/08863 teach the claimed contactless portable object, but lack the explicit teaching of a peripheral device includes a means for receiving energy and data, a display device, a secondary chip, a keyboard, being built in the same plane as the main antenna. However, Teicher et al. teach or fairly suggest these features (e.g., 15A, 15B, 15C). One skilled in the art would have been motivated to modify Berthold et al., as modified by PCT/US95/08863 to include the teachings of Teicher et al. for the purpose of utilizing smart cards which are based on the standards for integrated circuit cards and which exclude independent internal sources of power and visual displays (11:29-32).

With regard to **claim 17**, PCT/US95/08863 teaches receiving energy and data means is a flat coil (figs. 1, 3).

With regard to **claims 18-20**, Berthold et al., in view of PCT/US95/08863, and further in view of Teicher et al., inherently teach or fairly suggest the claimed conventional features of contactless portable devices and their associated reader. Official notice is taken that the claimed functioning of the flat coil, the generation of the energy and data are well known in the art for providing an inductive coupling between two devices. As such one skilled in the art would include the conventional features, to form a true contactless device, which receives its power externally.

Allowabl Subject Matter

8. Claims 26 and 28 are objected to as being dependent upon a rejected base claim, but **may** be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest, retromodulation of the response of the peripheral in combination with the other recited elements of claims 26 and claim 15.

The prior art of record does not teach or fairly suggest, removing the peripheral from the portable object in combination with the other recited elements of claim 15.

Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Nos. 4,277,837, 5,896,111, 6,019,284, 6,223,990, 6,236,220, and 6,367,701 disclose aspects of the claimed invention.

Communication with the PTO

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Polk whose telephone number is 703-308-6257. The examiner can normally be reached on M-F 7-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 703-308-3119. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

sp
July 12, 2003

A handwritten signature in black ink, appearing to read 'B. Sircus', with a stylized flourish at the end.

BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800